

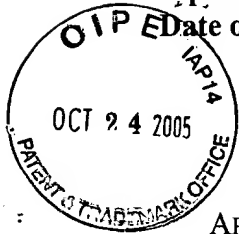
10-26-05

TW 1637
#

Express Mail Label No.: EV781042550US

Attorney Docket No.: 21465-501 CIP2

Date of Deposit: October 24, 2005



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Rothberg et al. CONFIRMATION NUMBER: 6233
SERIAL NUMBER: 09/814,338 EXAMINER: YOUNG J. KIM
FILING DATE: March 21, 2001 ART UNIT: 1637
FOR: *Method of Sequencing a Nucleic Acid*

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL LETTER

Transmitted herewith for filing in the present application are the following documents:

1. Supplemental Information Disclosure Statement (3 pages), in duplicate;
2. Modified Form 1449/PTO (1 page), in duplicate;
3. Cited References B90-B91;
4. Check #2879 for the amount of \$180.00; and
5. Return Postcard.

If the enclosed papers are considered incomplete, the Mail Room and/or the Application Branch is respectfully requested to contact the undersigned at (212) 935-3000.

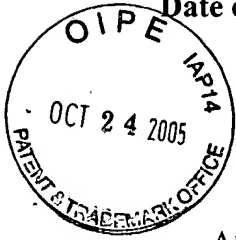
The Commissioner is authorized to charge any fees that may be due, or credit any overpayment of the same, to the undersigned's account, Deposit Account No. 50-0311 Ref. No. **21465-501 CIP2**. Please address all correspondence to customer number **35437**. A duplicate copy of this transmittal letter is enclosed herewith.

Respectfully submitted,

Dated: October 24, 2005

Ivor Elrifi, Reg. No. 39,529
Caryn DeHoratius, Reg. No. 45,881
Attorneys for Applicants
c/o MINTZ, LEVIN, COHN, FERRIS
GLOVSKY & POPEO P.C.
Chrysler Center
666 Third Avenue, 24th Floor
New York, New York 10017
Phone: (212) 935-3000
Fax: (212) 983-3115

Date of Deposit: October 24, 2005



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANTS: Rothberg et al. CONFIRMATION NUMBER: 6233
SERIAL NUMBER: 09/814,338 EXAMINER: Young J. Kim
FILING DATE: March 21, 2001 ART UNIT: 1637

FOR: *Method of Sequencing a Nucleic Acid*

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT

Documents Submitted as Part of Applicants' Reply to Office Action

Further to the Supplemental Amendment and Response filed on October 14, 2005, Applicants point out that the documents presented as Exhibits 1-5 in the Response need not be submitted in an Information Disclosure Statement to be considered by the Examiner. MPEP §609(III)(C)(3) clearly provides that:

Occasionally, documents are submitted and relied on by an applicant when replying to an Office action. These documents may be relied on by an applicant, for example, to show that an element recited in the claim is operative or that a term used in the claim has a recognized meaning in the art. Documents may be in any form but are typically in the form of an affidavit, declaration, patent, or printed publication.

To the extent that a document is submitted as evidence directed to an issue of patentability raised in an Office action, and the evidence is timely presented, applicant need not satisfy the requirements of 37 CFR 1.97 and 37 CFR 1.98 in order to have the examiner consider the information contained in the document relied on by applicant. In other words, compliance with the information disclosure rules is not a threshold requirement to have information considered when submitted by applicant to support an argument being made in a reply to an Office action.

Because the documents presented as Exhibits 1-5 were presented as evidence directed to an issue of patentability (objective evidence of nonobviousness), Applicants need not list such

references in an Information Disclosure Statement. *See* MPEP §609(III)(C)(3). Consideration of the submitted references is respectfully requested.

Documents Submitted in Form PTO-1449

Pursuant to the duty of disclosure under 37 C.F.R. §§1.56, 1.97 and 1.98, Applicant hereby makes of record the documents listed on the attached modified Supplemental Form PTO-1449 (submitted in duplicate) in the above-identified application, copies of which are submitted herewith.

This Supplemental Information Disclosure Statement is being filed more than three months after the filing date of this application but before the mailing date of a Notice of Allowance under 37 C.F.R. §1.311. Accordingly, the fee of \$180 as set forth in 37 C.F.R. §1.17(p) is enclosed.

It is respectfully requested that the Examiner consider completely the cited information, along with any other information, in reaching a determination concerning the patentability of the present claims. It is also respectfully requested that the Examiner initial, sign and date, and return a copy of the signed modified Supplemental Form PTO-1449 with the next U.S. Patent and Trademark Office communication, to evidence that the cited information has been fully considered by the U.S. Patent and Trademark Office during the examination of this application.

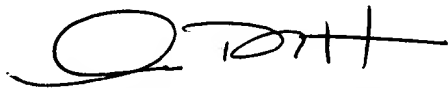
By submitting this Supplemental Information Disclosure Statement, the Applicants make no representation that: (1) a search has been performed, the extent of any search performed, or that more relevant information does not exist; (2) the information cited in the Statement is, or is considered to be, material to patentability as defined in 37 C.F.R. §1.56(b); and (3) the information cited in the Statement is, or is considered to be, in fact, prior art as defined by 35 U.S.C. §102.

The order of presentation of the references should not be construed as an indication of the importance of the references. The Examiner is urged to form his/her own conclusion regarding the relevance of the cited information.

Please charge any additional fees that may be due, or credit any overpayment of same, to
Deposit Account No. 50-0311, Reference No. 21465-501 CIP2.

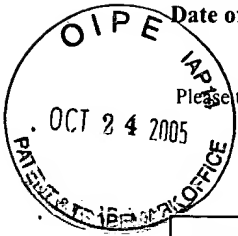
Respectfully submitted,

Dated: October 24, 2005

A handwritten signature in black ink, appearing to read 'Ivori Elrifi', written over a horizontal line.

Ivor Elrifi, Reg. No. 39,529
Caryn DeHoratius, Reg. No. 45,881
Attorneys for Applicants
c/o MINTZ, LEVIN, COHN, FERRIS, *et al.*
Chrysler Center
666 Third Avenue, 24th Floor
New York, New York 10017
Phone: (212) 935-3000
Fax: (212) 983-3115

Date of Deposit: October 24, 2005



Please type a plus sign (+) in this box



PTO/SB (12-97)

OMB 0651-0031

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

Modified Form 1449/PTO SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT BY APPLICANT (use as many sheets as necessary)	Application Number	09/814,338
	Filing Date	03/21/01
	First Named Inventor	Rothberg
	Group Art Unit	1637
	Examiner Name	Young J. Kim
	Attorney Docket Number	21465-501 CIP2

U.S. PATENT DOCUMENTS							
Exam Initials	Cite No.	U.S. Patent Document No.	Issue Date	Name of Patentee(s) or Applicant(s)	Class	Sub Class	Filing Date If Appropriate

FOREIGN PATENT DOCUMENTS							
Exam Initials	Cite No.	Foreign Patent Document Office Number		Name of Patentee(s) or Applicant(s)	Date of Publication	English Yes No	
	B90	WO	97/19193	Yale University	May 29, 1997	X	
	B91	WO	98/58079	Krull, et al.	December 23, 1998	X	

OTHER PRIOR ART – NON PATENT LITERATURE DOCUMENTS		
Exam Initials	Cite No.	Name of Author, Title (when appropriate), Publication, Volume, Page(s), Date, Etc.

*a copy of this reference is not provided as it was previously cited by or submitted to the office in a prior application, Serial No. _____, filed _____, and relied upon for an earlier filing date under 35 U.S.C. §120 (continuation, continuation-in-part, and divisional applications).

Examiner Signature		Date Considered	
--------------------	--	-----------------	--

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; Draw line through citation if not in conformance and not considered.

Include copy of this form with next communication to applicant.